



Atty. Dkt. No. 30002458-5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Martin Warwick BEALE et al.
Title: IMPROVEMENTS RELATING
TO NETWORKING
Appl. No.: 10/030,041
Filing Date: 01/7/2002
Examiner: Khai Tran
Art Unit: 2637

**PETITION UNDER 37 CFR 1.59(b) TO EXPUNGE
PROPRIETARY INFORMATION SUBMITTED UNDER MPEP § 724.02**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests that the Proprietary Information Disclosure Statement (PIDS) filed August 20, 2003 be expunged and that the documents be appropriately disposed of in accordance with 37 CFR 1.59.

Applicant submits the following information in support of this petition to expunge:

1. The August 20, 2003 PIDS was submitted per MPEP § 724 and § 724.02.
2. The petitioner will retain the proprietary information for the period of any patent with regard to which such information is submitted.
3. The items listed in the PIDS are requested to be expunged as they are deemed to be trade secret material, proprietary material, and/or subject to a protective order.
4. The information being expunged has not been otherwise made public.
5. This petition to expunge is being submitted by the same party who originally submitted the PIDS.

Applicants request that the petition fee of \$130.00 be charged to Deposit Account
No.: 08-2025.

08/03/2005 MBEYENE2 00000002 082025 10030041

03 FC:1463 200.00 DA

Applicant therefore requests the PTO to appropriately dispose of the August 20, 2003
PIDS.

Respectfully submitted,

Date 8/30/05

By 

HEWLETT-PACKARD COMPANY

Customer No.: 22879

Telephone: (202) 672-5485

Facsimile: (202) 672-5399

William T. Ellis

Attorney for Applicant

Registration No. 26,874



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PETITION UNDER 37 C.F.R. § 1.181

ATTN: Office of Petitions
Mail Stop **Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The applicant petitions to have the Examiner consider a reference which was submitted in a Proprietary IDS on 08/20/2003. In an Office Action dated 10/28/2004 the Examiner refused to consider the material on the sole basis that the reference was not listed on a form PTO-1449. This refusal was reiterated in the Notice of Allowability dated 05/06/2005.

It is submitted that the use of form PTO-1449 is not compulsory and therefore not proper grounds to refuse consideration of the submitted material. MPEP 609 (page 600-125) makes it clear that the use of form PTO-1449 is merely preferred as different from mandatory. Viz.:

Use of form PTO-1449, "Information Disclosure Citation," or PTO/SB/08A and 08B, "Information Disclosure Statement," is **encouraged** as a means to provide the required list of information as set forth in 37 CFR 1.98(a)(1). Applicants are **encouraged** to use the USPTO forms when preparing an information disclosure statement. (Emphasis added)

MPEP 609 further states that:

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information.

The minimum requirements for an information disclosure statement submitting a publication in the manner set forth in § 609 on pages 600-127 to 600-129 (full text appended) may be summarized as follows:

- 1) A (1) Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and date and place of publication.
- 2) A (2) Legible copies of each publication or that portion which caused it be listed; and
- 3) A (3) A concise explanation of relevance for non-English language information.

Inasmuch as items 1) and 2) were complied with and the publication which was submitted was in the English language (rendering item 3 moot) it is submitted that the IDS filed on 08/20/2003 met all of minimum requirements.

It is respectfully submitted that at the very least all of the minimum requirements for an IDS were met. It is therefore courteously requested that the Commissioner have this error in procedure corrected by having the Examiner consider the material that was submitted.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025.

Respectfully submitted,

Date 8/1/05

By 

HEWLETT-PACKARD COMPANY
Customer No.: 22879
Telephone: (202) 672-5485
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William T. Ellis
Attorney for Applicant
Registration No. 26,874

APPENDIX

Multiple information disclosure statements may be filed in a single application, and they will be considered, provided each is in compliance with the appropriate requirements of 37 CFR 1.97 and 37 CFR 1.98. **Use of form PTO-1449, "Information Disclosure Citation," or PTO/SB/08A and 08B, "Information Disclosure Statement," is encouraged as a means to provide the required list of information as set forth in 37 CFR 1.98(a)(1). Applicants are encouraged to use the USPTO forms when preparing an information disclosure statement.** A copy of forms PTO-1449, "Information Disclosure Citation" and PTO/SB/08A and 08B are reproduced at the end of this section to indicate how the forms should be completed. The forms will enable applicants to comply with the requirement to list each item of information being submitted and to provide the Office with a uniform listing of citations and with a ready way to indicate that the information has been considered. (Emphasis added)

In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement must be (1) in compliance with the content requirements of 37 CFR 1.98, and (2) filed in accordance with the procedural requirements of 37 CFR 1.97. **The requirements as to content are discussed in subsection III.A below.** The requirements based on the time of filing the statement are discussed in subsection III.B below. Examiner handling of information disclosure statements is discussed in subsection III.C below. >For discussion of IDS filed electronically (e-IDS) via the Office's Electronic Filing System (EFS), see subsection IV. below.< (Emphasis added)

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above. ** Information submitted to the Office that does not comply with the requirements of 37 CFR 1.97 and 37 CFR 1.98 will not be considered by the Office but will be placed in the application file. (Emphasis added)

III. MINIMUM REQUIREMENTS FOR AN INFORMATION DISCLOSURE STATEMENT

A. Content

An information disclosure statement must comply with the provisions of 37 CFR 1.98 as to content for the information listed in the IDS to be considered by the Office. Each information disclosure statement must comply with the applicable provisions of subsection III.A(1), A(2), and A(3) below.

A (1) List of All Patents, Publications, U.S. Applications, or Other Information

Each information disclosure statement must include a list of all patents, publications, U.S. applications, or other information submitted for consideration by the Office.

37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent, the applicant should list the patent in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. **Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and date and place of publication.** The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

The list of information complying with the identification requirements of 37 CFR 1.98(b) may not be incorporated into the specification of the application in which it is being supplied, but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A copy of a separate list (generated by the Office) will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of either form PTO-1449, Information Disclosure Citation, or PTO/SB/08A and 08B, Information Disclosure Statement, to list the documents is encouraged. See subsection C(2) below.

A (2) Legible Copies

In addition to the list of information, each information disclosure statement must also include a legible copy of:

(A) Each U.S. patent application publication, and U.S. ** patent >, with the exception that copies of such U.S. patent documents are not required if the IDS is electronically submitted via EFS or the IDS is filed in an application filed after June 30, 2003 or entered the national stage under 35 U.S.C. 371 after June 30, 2003. See subsection IV. below for a discussion of e-IDS<;

(B) >Each foreign patent document;

(C) <Each publication or that portion which caused it to be listed;

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(D) < For each cited pending >unpublished< U.S. application, the application specification including the claims, and any drawings of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

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(E) < All other information or that portion which caused it to be listed. 37 CFR 1.98(a)(2)(iii) requires a copy of a pending U.S. application that is being cited in an IDS. If the pending U.S. application is only identified in the specification's background information rather than being part of an IDS submission, a copy need not be supplied. Pursuant to 37 CFR 1.98(a)(2)(iii), applicant may choose to cite only a portion of a pending application including any claims directed to that portion rather than the entire application. There are exceptions to this requirement that a copy of the information must be provided. First, 37 CFR 1.98(d) states that a copy of any patent, publication, pending U.S. application, or other information listed in an information disclosure statement is not required to be provided if: (1) the information was previously cited by or submitted to, the Office in a prior application, provided that the prior application is properly identified in the IDS and is relied on for an earlier filing date under 35 U.S.C. 120; and (2) the IDS submitted in the earlier application complies with 37 CFR 1.98(a)-(c). If both of these conditions are met, the examiner will consider the information previously cited or submitted to the Office and considered by the Office in a prior application relied on under 35 U.S.C. 120. This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty. If the information cited or submitted in the prior application was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application. See subsection III.A(3) below. Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list, form PTO-1449, or PTO/SB/08A and 08B, submitted, e.g., by crossing out the listing of the cumulative information. But see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1374, 54 USPQ2d 1001, 1005 (Fed. Cir. 2000) (Reference was not cumulative since it contained a more complete combination of the claimed elements than any other reference before the examiner. "A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references." (citations omitted).). 37 CFR 1.98(a)(3)(ii) states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

A (3) Concise Explanation of Relevance for Non-English Language Information

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein with the page(s) and lines of the specification where it is incorporated being noted in the IDS.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

If information cited or submitted in a prior application relied on under 35 U.S.C. 120 was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.

The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. However, see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1376, 54 USPQ2d 1001, 1007 (Fed. Cir. 2000) ("[A]lthough MPEP Section 609A(3) allows the applicant some discretion in the manner in which it phrases its concise explanation, it nowhere authorizes the applicant to intentionally omit altogether key teachings of the reference.").

In *Semiconductor Energy Laboratory*, patentee during prosecution submitted an untranslated 29-page Japanese reference as well as a concise explanation of its relevance and an existing one-page partial English translation, both of which were directed to less material portions of the reference. The

untranslated portions of the Japanese reference "contained a more complete combination of the elements claimed [in the patent] than anything else before the PTO." 204 F.3d at 1376, 54 USPQ2d at 1005. The patentee, whose native language was Japanese, was held to have understood the materiality of the reference. "The duty of candor does not require that the applicant translate every foreign reference, but only that the applicant refrain from submitting partial translations and concise explanations that it knows will misdirect the examiner's attention from the reference's relevant teaching." 204 F.3d at 1378, 54 USPQ2d at 1008.

Although a concise explanation of the relevance of the information is not required for English language information, applicants are encouraged to provide a concise explanation of why the English-language information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability. (Emphasis added)